

REMARKS

The Office Action has been received and carefully considered. Claims 1-18 are pending in the present patent application. In this response, claims 9-12 are amended.

No new matter has been introduced by this Amendment.

Reconsideration of the current rejections in the present application is respectfully requested based on the following remarks.

A. **The 35 U.S.C. 101 Rejection**

In the Office Action, claims 9-12 are rejected under 35 U.S.C. 101. The Office Action asserts the claimed invention is directed to non-statutory subject matter. The Office Action sets forth asserted basis for the 35 U.S.C. 101 rejection.

In order to expedite prosecution of the present application, the rejected claims are amended to more clearly recite statutory subject matter under 35 U.S.C. 101. Withdrawal of the 35 U.S.C. 101 rejection is requested.

B. **The 35 U.S.C. 102 Rejection Based on DeTore**

Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by DeTore et al. (Patent No.: 4,975,840). This rejection is respectfully traversed.

The features of claim 1 are set forth above.

The Office Action asserts that DeTore teaches the various claimed features. In particular, the Office Action alleges that DeTore teaches:

assessing a consistency between the medication information and the medical condition information, the assessing a consistency between the medication information and the medical condition information performed by the processor (see at least Col. 5, line 40 through Col. 6, line 9; and Col. 10, line 31 through Col. 11, line 36); and

making at least one insurance underwriting decision based on the **consistency** between the medication information and the medical condition information (see at least

Figure 1; Col. 3, line 63 through Col. 6, line 8; Col. 5, line 40 through Col. 6, line 9; and Col. 10, line 31 through Col. 11, line 36).

(emphasis added)

Applicant submits that DeTore fails to support the assertions set forth in the Office

Action. Illustratively, DeTore describes (at column 5, lines 40 - column 6, line 9, as referenced in the Office Action):

For purposes of this discussion, the term "problem" will generally mean an element of information (e.g., facts and conditions such as age, a medical condition, a hazardous avocation, a smoking or drinking habit, etc.) stored in application data base 20 which impacts either positively or negatively upon the relative mortality of the proposed insured. The term "impairment" will generally mean an element of information (e.g., the impacts of aging, various medical conditions, avocations, smoking, drinking, etc. on the mortality of known populations) stored in underwriting knowledge base 24 **which relates to or corresponds with the information contained in application data base 20**. Each impairment is associated with textual information and/or an expert system or module which is intended to assist the system operator in quantifying the impact of a particular problem (by reference to a **corresponding** impairment) upon expected mortality in a particular instance. In broad terms, the approach to evaluating or underwriting a given risk which is incorporated into the process of the present invention includes the following steps:

1. Identifying a problem from the information contained in application data base 20;
2. **Matching or correlating the identified problem with a corresponding impairment from underwriting data base 24;**
3. Assigning weights (i.e., debits or credits) to the identified problems on the basis of information contained in the underwriting data base; and
4. Determining a risk classification for the given risk by combining the assigned weights.

As will be seen from the discussion which follows, the system of the present invention is capable of completing this process without the aid or intervention of skilled underwriters or other personnel in some cases and, in more difficult cases, is helpful in improving the efficiency, quality, and consistency of decisions which do require input from skilled underwriters.

(emphasis added)

Such teachings of DeTore are fundamentally different than the claimed features. That is, claim 1 recites "assessing a consistency between the medication information and the medical condition information ..." DeTore's teaching set forth above simply does not assess the

consistency of factors, so as to teach the claimed invention. Rather, as set forth above, DeTore teaches matching or correlating the identified problem with a corresponding impairment. Such processing is simply different vis-à-vis the claimed “assessing a consistency.”

To explain further, in regards to DeTore’s teaching, the matching or correlating of DeTore is of the likes of a mapping process, i.e., an identified problem is mapped to a corresponding impairment. In contrast, the claimed invention relates to a comparison and not a mapping. In other words, the parameters of DeTore may be correlated even though it does not make sense to say that such two parameters are “consistent.” Applicant submits that such highlights the distinction between the two concepts.

Further, claim 1 does not generally recite assessing a consistency between factors, but rather recites assessing a consistency between two specific factors, i.e., medication information vis-à-vis medical condition information. DeTore provides no such teaching. For example, DeTore’s chart of column 10, lines 42-55, fails to describe such particulars.

Applicant submits that claim 1 distinguishes over DeTore at least for the reasons set forth above.

Regarding claims 5, 9, and 13, these claims recite subject matter related to claim 1. Thus, at least some of the arguments set forth above with respect to claim 1 are equally applicable to claims 5, 9, and 13. Accordingly, it is respectfully submitted that such claims are allowable over DeTore for the same reasons as set forth above with respect to claim 1.

The various dependent claims should also be allowable at least by virtue of their respective dependency on the independent claims. Moreover, these claims recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

In view of the foregoing, it is respectfully requested that the aforementioned anticipation rejection of the claims be withdrawn.

C. The 35 U.S.C. 103 Rejection

In the Office Action, claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeTore et al. (Patent No.: 4,975,840), and further in view of the publication by McMillan et al. (Publication No.: US 2004/0039710). The rejection is traversed.

As set forth in the Office Action, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) include:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

It is respectfully submitted that the obviousness rejection of claims 17 and 18 is moot in view of the deficiencies of the applied art (i.e., DeTore) as discussed above.

That is, Applicant submits that the modification of DeTore based on the teachings of McMillan fails to cure the deficiencies of the rejection, as discussed above. That is, Applicant submits that even if it were obvious to modify DeTore based on the teachings of McMillan as asserted in the Office Action, which is not admitted by Applicant, such combination of applied art would still fail to fairly teach or suggest the claimed invention. Further, Applicant submits that such dependent claims recite patentable subject matter for at least reasons similar to those set forth above, as well as the additional features such dependent claims recite.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection under 35 U.S.C. 103 be withdrawn.

D. Conclusion

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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